UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,160	11/30/1999	STEVEN R. BOAL	80.142-002	8692

7590 03/02/2006

RONALD P. KANANEN, ESQ.
RADER, FISHMAN & GRAUER P.L.L.C.
1233 20TH STREET N.W.
SUITE 501
WASHINGTON, DC 20036

EXAMINER	
DURAN, ARTHUR D	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/451,160	BOAL, STEVEN R.	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 22-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 22-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-18 and 22-46 have been examined.

Response to Amendment

2. The Appeal Brief filed on 12/8/05 is sufficient to overcome the prior rejection. A new rejection has been issued.

Claim Rejections - 35 USC § 112

3. Claim 25 recites the limitation "the displayed coupon" and "the coupon displayed to the user". There is insufficient antecedent basis for this limitation in the claim. Claim 25 is dependent upon Claim 24 and there is no antecedent basis for "the displayed coupon". Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 24, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Linden (6,360,254).

Claims 24 and 25: Linden discloses associating a URL with a coupon, a promotional code being appended to the URL; invoking use of the URL with a browser to thereby enable a user to redeem the coupon; disabling future use of the invoked URL; and displaying coupons, gift certificates, and other objects which can be selected (Figures 1, 2, 3a, 5, 8, 9, 10; and the below citations):

"In a Web site system in which different private records or other resources are personal to different users, a method is provided for allowing users to securely access a private resource without the need to enter a username, password, or other authentication information, and without the need to download special authentication software or data to the user's computer. Each resource is assigned a private uniform resource locator (URL) which includes a fixed character string and a unique token, and the URLs are conveyed by email (preferably using hyperlinks) to users that are entitled to access such resources. The tokens are generated using a method which distributes the tokens substantially randomly over the range of allowable token values ("token space"). The token space is selected to be sufficiently large relative to the expected number of valid tokens to inhibit the identification of valid tokens through trial and error. When a user attempts to access a private URL (such as to access a private account information page), a token validation program is used to determine whether the token is valid. The method may be used to provide users secure to access private account information on the Web site of merchant. Other practical applications include electronic gift certificate and coupon redemption, gift registries, order confirmation electronic voting, and electronic greeting cards (Abstract);

[Claim] 29. The computer system of claim 16, wherein the server system implements

an electronic coupon system in which the private URLs provide one-time-use discounts to users.

5. Claims 26-28, 30-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Lang (2003/0083931).

Claim 26, 28, 30-33, 39-42, 44, 45, 46:

collecting device information from a client system, the device information being insufficient to specifically identify the user of the client system;

associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user;

selecting said coupon according to the device ID to thereby identify the coupon appropriate for said user based on the device information; and,

transmitting the selected coupon from the main server system to the client system (Fig 2; Fig. 3; Abstract; Paragraphs [9; 11; 14; 15; 17]).

Notice in the above citations from Lang that the electronic device and/or the user may be targeted and tracked. Hence, Lang discloses that the electronic device, without a specific identification of the user, can be tracked and targeted (see the above citations, particularly paragraph [17]).

Note in Paragraph [17] that Lang states that "In addition. . .the actual name may. . .may also be collected. . .". Also, notice in Lang that the information concerning user devices is available without intruding on the user.

Therefore, it would be obvious to one skilled in the art that Lang's invention can be enacted without necessarily accessing the specifically user identifying information but rather based on the device information. One would be motivated to do this in order to target users based on the available information and without further intruding the users.

Also, while Lang discloses advertising targeted to user devices, Lang does not explicitly disclose coupons.

However, Lang discloses marketing, advertising, and promotions ([3]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Lang's targeted marketing, advertising, and promotions can include coupons. One would have been motivated to do this in order to present marketing, advertising, and promotions that are in a form of possible interest to the user.

Claim 27: In regards to claim 27, Lang discloses obtaining location related information ([17, 29]). Lang does not explicitly disclose utilizing postal or zip codes. However, Lang discloses determining location automatically, and also collecting information

Claims 34, 35: Lang discloses the above but neither of the references explicitly disclose that the graphical user interface on the client device uses icons which may also flash to indicate the availability of new coupons. However, Official Notice is again taken that the use of icons, graphics, colors, animation, etc. to attract the viewer's attention on graphical user interfaces is well known in the computer arts, and their use would have been obvious to one having ordinary skill in the art at the time the invention was made. In support of this Official Notice, the Examiner previously provided excerpts from two HTML textbooks from 1996 to show that, not only was it well known to "flash" parts of a web page to attract the user's attention, but that the

"Blink" command was also one of the standard commands in the programming language (Graham, "The HTML Sourcebook, Second Edition, A Complete Guide of HTML 3.0", 1996, pp 233-234)(Lemav, "Teach Yourself Web Publishing with HTML 3.0 in a Week", 1996, pp 183). Therefore, one would have been motivated to use icons, flashing or otherwise, to notify the user of the Lang system in order to attract their attention more easily.

Claims 36, 37, 38, 43: Lang discloses the above, but neither reference explicitly discloses that the coupon data is encrypted before it is sent to the client system nor that the client system will also encrypt the coupon data upon receiving the data from the remote server. Official Notice is taken that it is old and well known within the computer and data encryption arts to encrypt data being sent over unsecured networks using a plurality of encryption methods in order to provide a higher level of security to the data. In support of this Official Notice the Examiner previously provided Chapter 15 from a cryptography textbook from 1996 to show that not only was double encryption a well known method to further protect data, but triple encryption and other multiple encryption schemes were also well known and used in the art (Schneier, "Applied Cryptography, Second Edition", 1996, pp 357-368). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the coupon data in Lang, prior to transmitting the data over an unsecured network, such as the Internet as disclosed by Lang, in order to prevent unauthorized interception of the data. It also would have been obvious to one having ordinary skill in the art at the time the invention was made to use a local encryption method to further encrypt and protect the encrypted data received from the remote server. One would have been motivated to further encrypt the coupon data in Lang, locally in this

manner in order to prevent unauthorized disclosure of the selected coupons to other persons who may use the client device (e.g. other family members, co-workers, etc.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-3, 5-18 and 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden (6,360,254) in view of Lang (2003/0083931).

Linden discloses the features of claims 24 and 25.

Claims 1-3, 5-18 and 22, 23 are dependent upon claims 24 and 25.

Claims 1-3, 5-8, 14-17:

Linden further discloses the user utilizing the Internet and accessing webpages, shopping, and receiving advertising (Fig. 5, 7, 9, 10).

Linden does not explicitly disclose targeting devices.

However, Lang discloses targeting devices.

In regards to claims 1-3, 5-8, 14-17, Lang discloses:

collecting device information from a client system, the device information being insufficient to specifically identify the user of the client system;

associating a device ID with the device information at a main server system, the device ID being insufficient to specifically identify the user;

selecting said coupon according to the device ID to thereby identify the coupon appropriate for said user based on the device information; and,

transmitting the selected coupon from the main server system to the client system (Fig 2; Fig. 3; Abstract; Paragraphs [9; 11; 14; 15; 17]).

Notice in the above citations from Lang that the electronic device and/or the user may be targeted and tracked. Hence, Lang discloses that the electronic device, without a specific identification of the user, can be tracked and targeted (see the above citations, particularly paragraph [17]).

Note in Paragraph [17] that Lang states that "In addition. . .the actual name may. . .may also be collected. . .". Also, notice in Lang that the information concerning user devices is available without intruding on the user.

Therefore, it would be obvious to one skilled in the art that Lang's invention can be enacted without necessarily accessing the specifically user identifying information but rather based on the device information. One would be motivated to do this in order to target users based on the available information and without further intruding the users.

Also, while Lang discloses advertising targeted to user devices, Lang does not explicitly disclose coupons.

However, Lang discloses marketing, advertising, and promotions ([3]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Lang's targeted marketing, advertising, and promotions can include coupons. One

would have been motivated to do this in order to present marketing, advertising, and promotions that are in a form of possible interest to the user.

Also, in regards to claim 2, Lang discloses obtaining location related information ([17, 29]). Lang does not explicitly disclose utilizing postal or zip codes. However, Lang discloses determining location automatically, and also collecting information

In the above, Lang discloses that user devices can be targeted and that the user device can be useful for determining information that will be of more likely interest to the user.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Lang's targeting devices to Linden's user utilizing the Internet and accessing webpages, shopping, and receiving advertising. One would have been motivated to do this in order to better present offers of interest to the user.

Claims 9 and 10: Lang discloses the above but neither of the references explicitly disclose that the graphical user interface on the client device uses icons which may also flash to indicate the availability of new coupons. However, Official Notice is again taken that the use of icons, graphics, colors, animation, etc. to attract the viewer's attention on graphical user interfaces is well known in the computer arts, and their use would have been obvious to one having ordinary skill in the art at the time the invention was made. In support of this Official Notice, the Examiner previously provided excerpts from two HTML textbooks from 1996 to show that, not only was it well known to "flash" parts of a web page to attract the user's attention, but that the "Blink" command was also one of the standard commands in the programming language (Graham, "The HTML Sourcebook, Second Edition, A Complete Guide of HTML 3.0", 1996, pp 233-234)(Lemav, "Teach Yourself Web Publishing with HTML 3.0 in a

Week", 1996, pp 183). Therefore, one would have been motivated to use icons, flashing or otherwise, to notify the user of the Linden system in order to attract their attention more easily.

Claims 11-13, 18, 22, 23: Lang discloses the above, but neither reference explicitly discloses that the coupon data is encrypted before it is sent to the client system nor that the client system will also encrypt the coupon data upon receiving the data from the remote server. Official Notice is taken that it is old and well known within the computer and data encryption arts to encrypt data being sent over unsecured networks using a plurality of encryption methods in order to provide a higher level of security to the data. In support of this Official Notice the Examiner previously provided Chapter 15 from a cryptography textbook from 1996 to show that not only was double encryption a well known method to further protect data, but triple encryption and other multiple encryption schemes were also well known and used in the art (Schneier, "Applied Cryptography, Second Edition", 1996, pp 357-368). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the coupon data in Lang, prior to transmitting the data over an unsecured network, such as the Internet as disclosed by Lang, in order to prevent unauthorized interception of the data. It also would have been obvious to one having ordinary skill in the art at the time the invention was made to use a local encryption method to further encrypt and protect the encrypted data received from the remote server. One would have been motivated to further encrypt the coupon data in Linden, locally in this manner in order to prevent unauthorized disclosure of the selected coupons to other persons who may use the client device (e.g. other family members, co-workers, etc.).

7. Claims 4 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden (6,360,254) in view of Lang (2003/0083931), for claim 4, or Lang (2003/0083931), for claim 29, in view of Barnett (6,231,208).

The prior art does not explicitly disclose printing the coupons. However, Barnett discloses uniquely identifying the coupons and printing the coupons (Fig. 1, 2, 3, 5; col 7, lines 20-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's printing coupons to Linden's providing coupons or Lang's providing advertisements. One would have been motivated to do this in order to better give the user a useful way to utilize the coupon/advertisement.

Response to Arguments

8. Applicant's arguments with respect to claims 1-18, 22-46 have been considered but are moot in view of the new ground(s) of rejection.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being

referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Woolston (20050262005) discloses URLs associated with coupons:

"[0054] The instance of the dynamic stream, the navlet of bid/ask information, may be further propagated or populated with electronic coupons 610 or advertisements, not shown. The electronic coupon 610 may provide a URL link and access code information to unlock or decode electronic coupon information to provide support for discount or loyalty program participation. In one mode of the system the navlet or dynamic bid/ask pricing streaming display may be vertically scaled to support one-half sized Internet advertising placards. In another mode of the system, the navlet may detect the horizontal size of the display on which it appears to horizontally scale the size of the navlet. The system, as discussed further below, may distribute Internet advertising and coupons based on taxonomic, user profile information, or other routable and distribution schemes provided by the system."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arthur Duran
Primary Examiner
2/17/2006